

Appl. No. 10/713,199  
Reply to Office Action of November 28, 2007  
Amendment filed

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Claims 1-14 are pending. Claim 9 is currently amended.

### **Remarks on Examiner's Response to Arguments**

The Examiner argues against Applicant's arguments filed on September 4, 2007. The Examiner states that "Applicant appears to be attacking the references separately by stating that Shioji does not disclose the invention as claimed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)."

Applicant respectfully submits that Applicant's arguments are proper because the Applicant is challenging the references for what the Examiner is relying on the references to teach. For example, regarding claim 1, on page 5 of the final office action, the Examiner states that Shioji does not explicitly teach that the arrow is shown either forward or backward depending on if the images are being selected in forward or backward order and relies on Vallone teaches these features. The Examiner's statement necessarily implies that Shioji teaches all other features of claim 1 except the features expressly stated by the Examiner as Shioji not teaching. Accordingly, Applicant submits arguments to challenge Shioji for the features that the Examiner relies on Shioji to teach and Applicant submits arguments to challenge Vallone for the features that the Examiner relies on Vallone to teach. In addition, Applicant also argues that Shioji alone or in combination with Vallone does not teach the features of the claims. Applicant is challenging the references by attacking the references individually for what the Examiner is relying on them to teach as well as attacking the combination of references.

Thus, Applicant respectfully submits that arguments against Shioji and Vallone are proper.

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**Rejection of claim 14 under 35 USC § 102(e) as being anticipated by Vallone (US 6642939)**

Applicant respectfully traverses this rejection.

An invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim. See MPEP § 2131.

The Examiner admits that Vallone does not explicitly disclose that the icon is stored in memory and alleges that it would have been inherent to store icons because there is no other conceivable place to store the icon and the icon is clearly stored somewhere because it is displayed (see office action, page 4). The Examiner fails to provide any evidence to support the inherency. Applicant submits that it would not have been inherent to store the icon "somewhere" simply because it is displayed. Vallone itself exemplifies at least one scenario where a object can be displayed and not stored. Specifically, Vallone discloses a trick play bar with a cache bar, a slider and a timing mark with a mode indicator 2705 that is displayed (col 20, lines 51-60), however, the mode indicator is not stored. Thus, Vallone fails to disclose *a memory device for storing an icon for indicating image display direction*, as claimed.

Additionally, embodiments of the present invention relate to still images. For example, paragraphs 00028 and 00029 of the specification describe photographing a still image of an object and transforming a digital still image signal of an object. Vallone on the other hand merely discloses a multimedia schedule presentation with video display, wherein a trick play bar 2601 is overlaid onto live video (col 19, lines 28-35). Vallone does not disclose generating still images. Vallone merely discloses live video display (see col 19, lines 29-31).

Applicant respectfully requests that if the Examiner maintains the rejection, then the Examiner provide evidentiary support for the inherency and issue the next office action as non-final so that the Applicant has an opportunity to respond.

Claim 14 is allowable at least for this reason.

**Rejection of claims 1-7 and 9-12 under 35 USC § 103(a) as being obvious over Shioji (US 7193646 B1) in view of Vallone (US 6642939)**

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Applicant respectfully traverses this rejection.

Shioji, alone and in combination with Vallone, does not disclose, teach or suggest the feature of claims 1-7 and 9-12. Shioji merely discloses a digital camera and method for classifying and reproducing images (see Abstract section).

Regarding claim 1, Shioji does not disclose *at least one memory device for storing the digital images and at least one icon for indicating image display direction and a processing device programmable to control the retrieval of an icon from a memory device*. Shioji's Fig 1, item 46 suggests a memory device and the mark "M" (as shown in Fig 6) that is merely a selection mark that is displayed on the reduced images. However, this does not disclose an icon that is stored in and retrieved from a memory device according to the features described in the claims. Shioji's mark "M" is merely displayed on the display screen.

The Examiner admits that Shioji does not disclose that the arrow either forward or backward depending on if the images are being selected in forward or backward order, and relies on Vallone to make up for Shioji's deficiencies. However, Vallone fails to make up for Shioji's deficiencies.

However, on page 4 of the office action, the Examiner admits that Vallone does not explicitly disclose that the icon is stored in memory. Vallone discloses an object that can be displayed and not stored. Specifically, Vallone discloses a track play bar with a cache bar, a slider and a timing mark with a mode indicator 2705 that is displayed (col 20, lines 51-60), however, the mode indicator is not stored. Thus, Vallone, alone or in any combination with Shioji, fails to disclose *at least one stored icon indicating image display direction, wherein the stored icon indicates one of a forward direction and a backward direction depending on whether said command selected the next digital image and the previous digital image, respectively, in the sequential display of the digital images, as described in the claims*. Shioji, alone and in combination with Vallone, does not disclose, teach or suggest the feature of claim 1. Accordingly, claim 1 is allowable.

Claims 2-7 are allowable at least because they depend from allowable base claim 1.

Claim 9 is allowable at least for reasons similar to claim 1.

Claims 10, 11 and 12 are allowable at least because they depend on allowable base claim 9.

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**Rejection of claims 8 and 13 under 35 USC § 103(a) as being obvious over Shioji (US US 7193646 B1) in view of Vallone (US 6642939) and further in view of English Abstract of JP 10-240218 (Takayanagi, cited in Applicant's IDS)**

Applicant respectfully traverses this rejection.

First, in the office action, the Examiner states that "Shioji nor the Examiner's Official Notice teach." Applicant assumes that the Examiner made a typographical mistake in citing to Official Notice and instead meant that "Shioji nor Vallone teach". In which case, Applicant submits that Shioji in view of Vallone does not disclose, teach or suggest the claimed feature and that Takayanagi fails to make up for Shioji's and Vallone's deficiencies.

Additionally, claims 8 and 13 are allowable at least because they depend from allowable base claims 1 and 9, respectively.

Specifically, Takayanagi, alone or in combination with Shioji and Vallone, does not disclose, teach or suggest the claimed features as alleged by the Examiner. Takayanagi relates to plotting icons and dynamically revising attitude, shape and color of an icon in order to efficiently utilize memory and processing speed. However, this disclosure does not teach to *selectively rotate said at least one icon for indicating image display direction on said display screen to indicate a forward direction icon and a backward direction icon depending on whether said command selected the next digital image and the previous digital image, respectively, in the sequential display of the digital images*, as described in the claims.

Accordingly, claims 8 and 13 are allowable.

### **Conclusion**

In view of the above, it is believed that the above-identified application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,



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